



PTO/SB/21 (08-03)

Approved for use through 08/30/2003. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

	Application Number	10/776,112	
	Filing Date	February 11, 2004	
	First Named Inventor	Vincent C. Conzola	
	Art Unit	2876	
	Examiner Name	Daniel A. Hess	
Total Number of Pages in This Submission	24	Attorney Docket Number	RPS920030163US1

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance communication to Technology Center (TC)
<input type="checkbox"/> Fee Attached Rspnse to Restriction Requirement	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Terminal Disclaimer	(1) Response to Notification of Non-Compliant Appeal Brief; (2) Amended Appeal Brief; (3) Postcard.
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Remarks	

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Winstead Sechrest & Minick, P.C. Robert A. Vogel, Jr., Reg. No. 47,159
Signature	
Date	September 27, 2005

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	Beatrice Zepeda
Signature	
Date	September 27, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



- 1 -

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	Before the Examiner:
Vincent C. Conzola	:	Daniel A. Hess
Serial No.: 10/776,112	:	Group Art Unit: 2876
Filing Date: February 11, 2004	:	
Title: PRODUCT CHECKOUT SYSTEM WITH ANTI-THEFT DEVICE	:	IBM Corporation P.O. Box 12195 Dept. 9CCA, Bldg. 002-2 Research Triangle Park, NC 27709

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notification of Non-Compliant Appeal Brief having a mailing date of September 21, 2005, with a time for response set to expire on October 21, 2005, Appellant responds as follows:

CERTIFICATION UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence (along with any item referred to as being enclosed herewith) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 27, 2005.

Beatrice Zepeda
Signature

Beatrice Zepeda
(Printed name of person certifying)

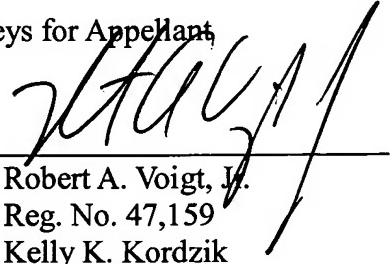
The Examiner asserts that Appellant's Appeal Brief does not contain all the items required under 37 C.F.R. §41.37. In particular, the Examiner asserts that the evidence appendix and the related proceedings appendix are missing. Appellant has amended the Appeal Brief (referred to as the "Amended Appeal Brief") by including these appendices. Accordingly, Appellant respectfully asserts that the Amended Appeal Brief is in compliance and respectfully requests the Examiner to withdraw the notice of non-compliance.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Appellant

By:


Robert A. Voigt, Jr.
Reg. No. 47,159
Kelly K. Kordzik
Reg. No. 36,571

P.O. Box 50784
Dallas, Texas 75201
(512)370-2832

292323v.1



RPS920030163US1

PATENT

- 1 -

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Vincent C. Conzola	:	Daniel A. Hess
Serial No.: 10/776,112	:	Group Art Unit: 2876
	:	
Filing Date: February 11, 2004	:	
	:	
Title: PRODUCT CHECKOUT	:	IBM Corporation
SYSTEM WITH ANTI-THEFT	:	P.O. Box 12195
DEVICE	:	Dept. 9CCA, Bldg. 002-2
	:	Research Triangle Park, NC 27709

AMENDED APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I. **REAL PARTY IN INTEREST**

The real party in interest is International Business Machines, Inc., which is the assignee of the entire right, title and interest in the above-identified patent application.

CERTIFICATION UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on September 21, 2005.

Beatrice Zepeda
Signature

Beatrice Zepeda
(Printed name of person certifying)

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

In a Reply under 37 C.F.R. § 1.111 filed on February 2, 2005, the Applicant cancelled claims 1-8 and 18-23. In the Final Office Action mailed on April 5, 2005, the Examiner acknowledges Applicant's February 2005 filing. (Final Office Action, Pg. 2). However, on pages 1 and 4-6 of the Final Office Action, the Examiner addresses the patentability of the cancelled claims despite those claims having already been cancelled. Assuming claims 1-8 and 18-23 were indeed cancelled, and further assuming that the Examiner's review of those claims in the Final Office Action was an oversight, the status of the claims is as follows:

Claims 9-17 and 24-32 are pending in the application.

Claims 9-17 and 24-32 are rejected.

The rejections for claims 9-17 and 24-32 are being appealed.

IV. STATUS OF AMENDMENTS

No amendments were filed subsequent to the final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER*Independent Claim 9*

Independent claim 9 concerns a check-out system with an anti-theft device. Such systems may be found in grocery or hardware stores whereby a store clerk scans

the bar code on a product and then deactivates a security tag on the product so the customer can leave the store without setting off any security alarms. The system of claim 9 improves check-out systems because it includes several steps such as (i) examining a product while the product is in a substantially enclosed area; (ii) establishing physical features for the product while it is in the substantially enclosed area (Fig. 6, References 620, 625); and (iii) deactivating the product's security tag while the product is in the substantially enclosed area (Fig. 6, References 620, 645). (Specification, Pg. 9, Lines 1-23; Fig. 7, Reference 710). Thus, the system of claim 9 (i) examines a product; (ii) establishes physical features for the product; and (iii) deactivates the product tag all while the product is in the substantially enclosed area. Therefore, because a product is examined, evaluated and deactivated in a substantially enclosed area, theft (*e.g.*, "sweet-hearting") is prevented because a thief is deterred from placing a second product (and likely more expensive product) in the deactivation field along with the product that was properly examined and evaluated.

Independent Claim 24

Independent claim 24 provides a check-out system comprising (i) an evaluator for establishing physical features for a product while the product is in a substantially enclosed area (Fig. 6, References 620, 625); and (ii) a deactivation device for deactivating the product security tag while the product is in the substantially enclosed area (Fig. 6, References 620, 645). (Specification, Pg. 9, Lines 1-23; Fig. 7, Reference 710). Thus, the system of claim 24 (i) establishes physical features and (ii) deactivates the product's tag all while the product is in the substantially enclosed area. Therefore, as indicated above when discussing claim 9, theft is deterred.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 9-17 and 24-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Bellis et al.* (U.S. Patent Application No. 2003/0024982) (hereafter "*Bellis*") in view of *Novak* (U.S. Patent No. 5,497,314) (hereafter "*Novak*").

VII. ARGUMENT

Claims 9-17 and 24-32 are rejected as being obvious in light of *Bellis* and *Novak*. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the asserted reference (or references when combined) must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combinations and their reasonable expectation of success must both be found in the asserted reference(s) and not based on applicant's disclosure. M.P.E.P. § 2142. The April 5, 2005 Final Office Action ("Office Action") does not meet this three-part burden and consequently, Applicant respectfully traverses the obviousness rejections.

Claims 9 - 17

Independent claim 9, and its dependent claims 10 - 17, are not obvious in light of *Bellis*, *Novak*, or *Bellis* in view of *Novak* for any of the following reasons.

A. Cited References Fail to Teach Every Element of Claim

Rejections under §103 require that the cited references teach *every* element of the claim. M.P.E.P. §2143.03. *Bellis*, *Novak*, or *Bellis* in light of *Novak* fail to teach *every* element of claim 9. Therefore, because the Office Action fails to satisfy one of

the three factors required to prove a *prima facie* case of obviousness, claim 9 is not obvious in light of the cited references.

Claim 9 provides:

A check-out method ... comprising the steps of:

...

examining said product while said product is in said substantially enclosed area;

establishing ... physical features for said product while said product is in said substantially enclosed area;

...

deactivating said tag ... while said product is in said substantially enclosed area.

Thus, claim 9 recites a method that "examine[s] said product", "establish[es] one or more physical features for said product", and "deactivat[es] said tag ... while said product is in said substantially enclosed area."

In contrast, the Office Action provides that (i) *Bellis* deactivates a product's security tag while the product is in the detection area and that (ii) *Novak* teaches "an enclosure cover[s] the detection area." Therefore, "using *Novak*'s teaching, an enclosure covered the detection area, and automatically this enclosure would also encompass the deactivation system, since *Bellis*' deactivation system occurs with products that are in the sensing area." (Office Action, pp. 3-4). However, further analysis of *Bellis* illustrates the shortcomings in this proposition.

Bellis provides:

The bagging station 270 may further include one or more electronic article – surveillance monitors 300 . . . for verifying that all the items have been scanned into the self-check out system 100 and deactivating

the magnetic security tag on the item. Alternatively, the electronic surveillance deactivator may also be incorporated within the identification-code leader 120.

(*Bellis*, p. 2, ¶ 19; Fig. 1). *Bellis* further provides:

The system 100 may also include an item-shape sensor 600 as shown in Figure 2. The item-shape sensor 600 may be positioned between the scanning/payment station 110 and the bagging station 270. The item-shape sensor 600 generally comprises a tunnel 602 with a conveyor belt 603 moving at the base of the tunnel 602.

(*Bellis*, p. 2, ¶ 20; Figs. 1-2). Thus, *Bellis* places an item-shape sensor 600 between the scanning station 110 and the bagging station 270. *Bellis* had earlier provided that any electronic article surveillance deactivator 120, 300 would be located in the scanning station 110 or bagging station 270. In short, *Bellis* provides an item-shape sensor 600, comprising a tunnel, that is located in between the disclosed locations for article surveillance deactivators 120, 300. Thus, *Bellis* does not teach or suggest the element in claim 9 concerning "deactivating said tag . . . while said product is in said substantially enclosed area."

Novak fails to remedy *Bellis'* shortcomings. *Novak* provides:

The items are placed on the conveyor by the customer, and are automatically conveyed into an enclosed housing containing an illumination source . . . and video imaging equipment . . . Digital image processing techniques and technology are used to identify the items by taking a digitized image of the object . . . By correlating the digital image of each object to additional identification characteristic of the item, a precise determination of proper identity is accomplished

....

(*Novak*, Col. 2, lines 12-31). Thus, *Novak* discloses an "enclosed housing" 4 (Fig. 1) wherein a product is analyzed. This housing is analogous to the tunnel 602 associated with the item-shape sensor 600 in *Bellis* (Fig. 2). Consequently, as far as use of a tunnel or house is concerned, *Novak* adds little to *Bellis*.

Put another way, when *Bellis* contemplated use of a tunnel to analyze a product, any deactivation of security tags took place outside of that tunnel at the scanning station 110 or the bagging station 270. (*Bellis*, p. 2, ¶ 19-20). *Novak* is just another example of a housing area used for analysis of a product. In short, neither *Bellis* nor *Novak*, or their combination, consider the deactivation of tags in a substantially enclosed area. In other words, a person of ordinary skill in the art looking at *Bellis* and/or *Novak* would appreciate no teaching or suggestion for the element in claim 9 concerning "deactivating said tag . . . while said product is in said substantial enclosed area." The only such teaching or suggestion is found in the applicant's disclosure. To avoid impermissible hindsight, judgments on obviousness may take into account only knowledge that was in the level of ordinary skill in the art and may not include knowledge gleaned only from the applicant's disclosure. M.P.E.P. § 2145; *In Re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971).

Consequently, Applicant respectfully asserts that the Examiner has failed to prove a *prima facie* case of obviousness in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak* because the references do not teach or suggest all of the elements of the claim (i.e., deactivating said tag ... while said product is in said substantially enclosed area.) M.P.E.P. §2143.03; *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998) (§103 rejections must not rely on incorrect factual predicates such as failing to appreciate differences between a claim and prior art.) As a result, claim 9 (and dependent claims 10 - 17) are not obvious in light of the cited references.

B. No Motivation to Combine the Cited References

Rejections under § 103 require evidence of some motivation or suggestion to modify the reference or to combine reference teachings. The cited references cannot be modified or combined as proposed by the Examiner due to the Examiner's failure

to provide a motivation to combine the cited references. M.P.E.P. § 2143.01. Therefore, because the Office Action fails to satisfy one of the three factors required to prove a *prima facie* case of obviousness, claim 9 is not obvious in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak*.

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the asserted reference(s), and the knowledge of persons of ordinary skill in the art. M.P.E.P. § 2143.01; *In Re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). These three sources are addressed below.

Nature of the Problem to be Solved

Claim 9 is not obvious in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak* considering the cited references cannot be modified or combined as proposed by the Examiner because the references address different problems (one of the three possible sources of motivation to combine references). M.P.E.P. § 2143.01.

A motivation to combine references may be based on the nature of the problem to be solved when each reference is directed to "precisely the same problem." *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270 (Fed. Cir. 2004).

Bellis addresses the following problem:

[T]he current self check out system may still require a high degree of store employee or operator intervention. Because a machine lacks the judgment of a human being, these systems tend to be very rigid and inflexible. Hence a need exists for a system that provides more efficient throughout and retains adequate security.

(*Bellis*, p. 1, ¶ 6). Thus, *Bellis* addresses security concerns and speed.

In contrast, *Novak* is directed towards the following problem:

Methods [that] provide a relatively simple system for the automated check-out of retail items as not dependent upon the involvement of customer or store personnel.

(*Novak*, Col. 1, line 66 – Col. 2, line 2). *Novak* addresses systems that are automated and, unlike *Bellis*, do not require human intervention. Thus, *Bellis* and *Novak* are not addressed towards "precisely the same problem." Therefore, the "nature of the problem" factor illustrates there is no suggestion or motivation to modify the references.

Thus, Applicant respectfully asserts that the Examiner has failed to prove a *prima facie* case of obviousness for claim 9 (as well as dependent claims 10 – 17) in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak*, considering the cited references cannot be modified or combined as proposed by the Examiner because the cited references address different problems (i.e., security vs. automated check-out). M.P.E.P. § 2143.01.

Teachings of the Asserted References

Claim 9 is not obvious in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak* because the teachings of the asserted references do not provide or suggest a motivation to modify or combine the references. M.P.E.P. § 2143.01.

The Office Action states that:

[T]he concept of 'teaching away' is based on the idea that a first invention would not function properly or would not fulfill its intended purpose if modified based on the teachings of the second invention . . . there is no reason to believe that surrounding the detecting area of *Bellis*' enclosure would somehow stop it from working properly.

(Office Action, p. 3). The Office Action fails to supply any legal precedent for this assertion. In fact, the concept of 'teaching away' is not so limited. For example, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. M.P.E.P., § 2141.02; *W.L.*

Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Furthermore, the general nature of the teaching is highly relevant in determining whether the references teach away from the claimed invention. M.P.E.P. § 2145 (X)(D); *In Re Gurly*, 27 F.3d 551, 554 (Fed. Cir. 1994).

Claim 9 provides the following: "deactivating said tag ... while said product is said substantially enclosed area." Doing so provides many advantages, one of which is the prevention of "sweethearting" by a thief. One example of "sweethearting" occurs when a thief uses a check-out system to deactivate a security tag on a first item that was or will be correctly paid for by a thief. While such a deactivation occurs, the thief places a second item (one he has no intention of paying for) in proximity to the first item. Consequently, the second item's security tag is wrongfully deactivated along with the first item's security tag. Claim 9 specifically addresses this issue because claim 9 "examine[s] said product", "establish[es] ... physical features for said product", and "deactivat[es] said tag ... while said product is in said substantially enclosed area." In short, claim 9 prevents sweethearting.

In contrast, *Bellis* provides that a "bagging station 270 may further include ... deactivators." (*Bellis*, p. 2, ¶ 19). The bagging station 270 is located in open space and is consequently susceptible to sweethearting. (Figure 1). *Bellis* also allows for the deactivator to be "incorporated within the identification-code reader 120." (*Bellis*, p. 2, ¶ 19). As was the case with the bagging station location, the identification-code reader is located in open space and is consequently susceptible to sweethearting. (*Bellis*, Fig. 1). Simply put, *Bellis* fails to even contemplate a significant advantage (i.e., prevention of sweethearting) provided by claim 9. Further, *Bellis* uses an open space for deactivation and thus teaches away from deactivation using an enclosed area.

Novak cannot remedy *Bellis'* shortcoming because *Novak* doesn't even address deactivating security tags. Instead, *Novak* targets the automated assessment of physical characteristics of objects – not theft prevention.

Thus, Applicant respectfully asserts that the Examiner has failed to prove a *prima facie* case of obviousness for claim 9 (as well as dependent claims 10 – 17) in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak*, considering the cited references cannot be modified or combined as proposed by the Examiner because they teach away from the claimed invention. M.P.E.P. § 2145(D) (*Bellis* uses an open space for deactivation and *Novak* does not address deactivation).

Knowledge of Persons of Ordinary Skill in the Art

Claim 9 is not obvious in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak* because the third possible source for a motivation to combine the references, the knowledge of persons of ordinary skill in the art, does not provide or suggest a motivation to modify or combine the references. M.P.E.P. § 2143.01; *In Re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998).

Even when a "technologically simple concept" is claimed, it must be a finding "as to the specific understanding of principle within the knowledge of the skilled art" that would have provided the motivation to use, combine or modify the references as proposed by the examiner. *In Re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). The Office Action lacks any such "specific understanding" and merely provides:

In view of *Novak*'s teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known measurement of physical characteristics in an enclosed area at the checkout because otherwise a would-be shoplifter might interfere with sensor results inside the measurement area. The examiner envisions a would-be shoplifter attempting to change product detection outcomes by interfering with the detected parameters . . . in

order to indicate to the sensor that there is a different/cheaper product present . . .

(Office Action, pp. 3-4). What "the examiner envisions" does not rise to the requirement for a "specific understanding." In fact, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. M.P.E.P. § 2143.01; *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). In short, the only evidence in the record regarding deactivating a security tag in a substantially enclosed area is in the applicant's disclosure. However, a suggestion or motivation to combine references may not be based on the applicant's disclosure. M.P.E.P. § 2142; *In Re Baeck*, 947 F.2d 488 (Fed. Cir. 1991).

Consequently, Applicant respectfully asserts that the Examiner has failed to prove a *prima facie* case of obviousness for claim 9 (as well as dependent claims 10-17) in light of the cited references, considering those references cannot be combined or modified as proposed by the Examiner because there is no suggestion or motivation to modify or to combine the reference teachings based on knowledge of persons of ordinary skill in the art. M.P.E.P. §2143.01; *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998) (court requires the examiner to show a motivation to combine the §103 references based on "nature of the problem", "teachings of the prior art" or "knowledge of persons of ordinary skill in the art").

In short, claim 9 and its dependent claims 10-17 are not obvious in light of *Bellis*, *Novak* or *Bellis* in light of *Novak* for at least the above reasons.

Claims 24 - 32

As in the case with claim 9, independent amended claim 24, and its dependent claims 25 - 32, are not obvious in light of *Bellis*, *Novak*, or *Bellis* in view of *Novak* for any of the following reasons.

Amended claim 24 provides:

A check-out system...comprising:

...

a[n] ... evaluator for establishing ... physical features ... while said product is in said substantially enclosed area;

...

a deactivation device for deactivating said tag ... while said product is in said substantially enclosed area.

Thus, amended claim 24 "establish[es] physical features" and "deactivat[es] said tag ... while said product is in said substantially enclosed area."

A. Cited References Fail to Teach Every Element of Claim

As was the case with claim 9, Applicant respectfully asserts that the Examiner has failed to prove a *prima facie* case of obviousness in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak* because the references do not teach or suggest all of the elements of the claim (i.e., a deactivation device for deactivating said tag ... while said product is in said substantially enclosed area.) M.P.E.P. §2143.03; *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998) (§103 rejections must not rely on incorrect factual predicates such as failing to appreciate differences between a claim and prior art.) As a result, claim 24 (and dependent claims 25 - 32) are not obvious in light of the cited references.

B. No Motivation to Combine the Cited References

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the asserted reference(s), and the knowledge of persons of ordinary skill in the art. M.P.E.P. § 2143.01; *In Re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). These three sources are addressed below.

As was the case with claim 9, Applicant respectfully asserts that the Examiner has failed to prove a prima facie case of obviousness for claim 24 (as well as dependent claims 25 – 32) in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak*, considering there is no motivation to combine the cited references because the cited references address different problems (i.e., security vs. automated check-out). M.P.E.P. § 2143.01.

Also, as was the case with claim 9, Applicant respectfully asserts that the Examiner has failed to prove a prima facie case of obviousness for claim 24 (as well as dependent claims 25 – 32) in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak*, considering there is no motivation to combine the cited references because they teach away from the claimed invention. M.P.E.P. § 2145(D) (*Bellis* uses an open space for deactivation and *Novak* does not address deactivation).

In addition, as was the case with claim 9, Applicant respectfully asserts that the Examiner has failed to prove a prima facie case of obviousness for claim 24 (as well as dependent claims 25-32) in light of the cited references, considering those references cannot be combined or modified as proposed by the Examiner because there is no suggestion or motivation to modify or to combine the reference teachings based on knowledge of persons of ordinary skill in the art. M.P.E.P. §2143.01; In re Rouffet, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998) (court requires the examiner to show a motivation to combine the §103 references based on "nature of the problem", "teachings of the prior art" or "knowledge of persons of ordinary skill in the art").

In short, claim 24, and its dependent claims 25 - 32, are not obvious in light of *Bellis*, *Novak*, or *Bellis* in view of *Novak* for at least the above reasons.

VIII. CONCLUSION

For the reasons noted above, the rejections of claims 9-17 and 24-32 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 9-17 and 24-32.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Appellants

By: _____

Kelly K. Kordzik

Reg. No. 36,571

Robert A. Voigt, Jr.

Reg. No. 47,159

P.O. Box 50784
Dallas, Texas 75201
(512) 370-2832

CLAIMS APPENDIX

1 9. A check-out method for a product having a security tag associated therewith,
2 comprising the steps of:

3 storing one or more physical characteristics for said product;
4 recalling said one or more physical characteristics when a consumer checks
5 out said product;

6 placing said product in a substantially enclosed area;
7 examining said product while said product is in said substantially enclosed
8 area;

9 establishing one or more physical features for said product while said product
10 is in said substantially enclosed area;

11 comparing said one or more physical characteristics to said one or more
12 physical features;

13 generating a signal if said one or more physical characteristics substantially
14 match said one or more physical features; and

15 deactivating said tag with a deactivation device after receipt of said signal and
16 while said product is in said substantially enclosed area.

1 10. The method according to claim 9 wherein said one or more physical
2 characteristics and said one or more physical features pertain to weight.

1 11. The method according to claim 9 wherein said one or more physical
2 characteristics and said one or more physical features pertain to size.

1 12. The method according to claim 9 wherein said one or more physical
2 characteristics and said one or more physical features pertain to shape.

1 13. The method according to claim 9 wherein said one or more physical
2 characteristics and said one or more physical features pertain to color.

1 14. The method according to claim 9 wherein said one or more physical
2 characteristics and said one or more physical features pertain to two or more of the
3 following: weight, size, shape, color or surface texture.

1 15. The method according to claim 9 further comprising the step of ensuring no
2 other object is in said substantially enclosed area once said product has been placed in
3 said substantially enclosed area but before said tag has been deactivated.

1 16. The method according to claim 15 further comprising the step of generating
2 an alert signal if an object, in addition to said product, is detected to be in said
3 substantially enclosed area once said product has been placed in said substantially
4 enclosed area but before said tag has been deactivated.

1 17. The method according to claim 16 further comprising the step of preventing
2 any deactivation of said tag once said alert signal has been generated.

1 24. A check-out system for a product having a security tag associated therewith,
2 comprising:

3 a substantially enclosed area;
4 a database for storing one or more physical characteristics for said product;
5 a scanner for retrieving from said database said one or more physical
6 characteristics;
7 a physical characteristic evaluator for establishing one or more physical
8 features for said product while said product is in said substantially enclosed area;
9 a computer for comparing said one or more physical characteristics to said one
10 or more physical features;
11 an electronic circuit for generating a signal if said one or more physical
12 characteristics substantially match said one or more physical features; and
13 a deactivation device for deactivating said tag after receipt of said signal and
14 while said product is in said substantially enclosed area.

1 25. The system according to claim 24 wherein said one or more physical
2 characteristics and said one or more physical features pertain to weight.

1 26. The system according to claim 24 wherein said one or more physical
2 characteristics and said one or more physical features pertain to size.

1 27. The system according to claim 24 wherein said one or more physical
2 characteristics and said one or more physical features pertain to shape.

1 28. The system according to claim 24 wherein said one or more physical
2 characteristics and said one or more physical features pertain to color.

1 29. The system according to claim 24 wherein said one or more physical
2 characteristics and said one or more physical features pertain to two or more of the
3 following: weight, size, shape, color or surface texture.

1 30. The system according to claim 24 further comprising a means for ensuring no
2 other object is in said substantially enclosed area once said product has been placed in
3 said substantially enclosed area but before said tag has been deactivated.

1 31. The system according to claim 30 further comprising means for generating an
2 alert signal if an object, in addition to said product, is detected to be in said
3 substantially enclosed area once said product has been placed in said substantially
4 enclosed area but before said tag has been deactivated.

1 32. The system according to claim 31 further comprising means for preventing
2 any deactivation of said tag once said alert signal has been generated.

EVIDENCE APPENDIX

No evidence was submitted pursuant to §§1.130, 1.131, or 1.132 of 37 C.F.R. or of any other evidence entered by the Examiner and relied upon by Appellant in the Appeal.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings to the current proceeding.

Austin_1\292321\1
7036-P255US 9/26/2005

- 1 -

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	Before the Examiner:
Vincent C. Conzola	:	Daniel A. Hess
Serial No.: 10/776,112	:	Group Art Unit: 2876
Filing Date: February 11, 2004	:	
Title: PRODUCT CHECKOUT SYSTEM WITH ANTI-THEFT DEVICE	:	IBM Corporation P.O. Box 12195 Dept. 9CCA, Bldg. 002-2 Research Triangle Park, NC 27709

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notification of Non-Compliant Appeal Brief having a mailing date of September 21, 2005, with a time for response set to expire on October 21, 2005, Appellant responds as follows:

CERTIFICATION UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence (along with any item referred to as being enclosed herewith) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September ___, 2005.

Signature

Beatrice Zepeda

(Printed name of person certifying)

The Examiner asserts that Appellant's Appeal Brief does not contain all the items required under 37 C.F.R. §41.37. In particular, the Examiner asserts that the evidence appendix and the related proceedings appendix are missing. Appellant has amended the Appeal Brief (referred to as the "Amended Appeal Brief") by including these appendices. Accordingly, Appellant respectfully asserts that the Amended Appeal Brief is in compliance and respectfully requests the Examiner to withdraw the notice of non-compliance.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Appellant

By: _____

Robert A. Voigt, Jr.

Reg. No. 47,159

Kelly K. Kordzik

Reg. No. 36,571

P.O. Box 50784
Dallas, Texas 75201
(512)370-2832

292323v.1

- 1 -

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: : Before the Examiner:
Vincent C. Conzola : Daniel A. Hess
Serial No.: 10/776,112 : Group Art Unit: 2876
Filing Date: February 11, 2004 :
Title: PRODUCT CHECKOUT : IBM Corporation
SYSTEM WITH ANTI-THEFT : P.O. Box 12195
DEVICE : Dept. 9CCA, Bldg. 002-2
Research Triangle Park, NC 27709

AMENDED APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I. **REAL PARTY IN INTEREST**

The real party in interest is International Business Machines, Inc., which is the assignee of the entire right, title and interest in the above-identified patent application.

CERTIFICATION UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on September __, 2005.

Signature

Beatrice Zepeda
(Printed name of person certifying)

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

In a Reply under 37 C.F.R. § 1.111 filed on February 2, 2005, the Applicant cancelled claims 1-8 and 18-23. In the Final Office Action mailed on April 5, 2005, the Examiner acknowledges Applicant's February 2005 filing. (Final Office Action, Pg. 2). However, on pages 1 and 4-6 of the Final Office Action, the Examiner addresses the patentability of the cancelled claims despite those claims having already been cancelled. Assuming claims 1-8 and 18-23 were indeed cancelled, and further assuming that the Examiner's review of those claims in the Final Office Action was an oversight, the status of the claims is as follows:

Claims 9-17 and 24-32 are pending in the application.

Claims 9-17 and 24-32 are rejected.

The rejections for claims 9-17 and 24-32 are being appealed.

IV. STATUS OF AMENDMENTS

No amendments were filed subsequent to the final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER*Independent Claim 9*

Independent claim 9 concerns a check-out system with an anti-theft device. Such systems may be found in grocery or hardware stores whereby a store clerk scans

the bar code on a product and then deactivates a security tag on the product so the customer can leave the store without setting off any security alarms. The system of claim 9 improves check-out systems because it includes several steps such as (i) examining a product while the product is in a substantially enclosed area; (ii) establishing physical features for the product while it is in the substantially enclosed area (Fig. 6, References 620, 625); and (iii) deactivating the product's security tag while the product is in the substantially enclosed area (Fig. 6, References 620, 645). (Specification, Pg. 9, Lines 1-23; Fig. 7, Reference 710). Thus, the system of claim 9 (i) examines a product; (ii) establishes physical features for the product; and (iii) deactivates the product tag all while the product is in the substantially enclosed area. Therefore, because a product is examined, evaluated and deactivated in a substantially enclosed area, theft (*e.g.*, "sweet-hearting") is prevented because a thief is deterred from placing a second product (and likely more expensive product) in the deactivation field along with the product that was properly examined and evaluated.

Independent Claim 24

Independent claim 24 provides a check-out system comprising (i) an evaluator for establishing physical features for a product while the product is in a substantially enclosed area (Fig. 6, References 620, 625); and (ii) a deactivation device for deactivating the product security tag while the product is in the substantially enclosed area (Fig. 6, References 620, 645). (Specification, Pg. 9, Lines 1-23; Fig. 7, Reference 710). Thus, the system of claim 24 (i) establishes physical features and (ii) deactivates the product's tag all while the product is in the substantially enclosed area. Therefore, as indicated above when discussing claim 9, theft is deterred.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 9-17 and 24-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Bellis et al.* (U.S. Patent Application No. 2003/0024982) (hereafter "*Bellis*") in view of *Novak* (U.S. Patent No. 5,497,314) (hereafter "*Novak*").

VII. ARGUMENT

Claims 9-17 and 24-32 are rejected as being obvious in light of *Bellis* and *Novak*. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the asserted reference (or references when combined) must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combinations and their reasonable expectation of success must both be found in the asserted reference(s) and not based on applicant's disclosure. M.P.E.P. § 2142. The April 5, 2005 Final Office Action ("Office Action") does not meet this three-part burden and consequently, Applicant respectfully traverses the obviousness rejections.

Claims 9 - 17

Independent claim 9, and its dependent claims 10 - 17, are not obvious in light of *Bellis*, *Novak*, or *Bellis* in view of *Novak* for any of the following reasons.

A. Cited References Fail to Teach Every Element of Claim

Rejections under §103 require that the cited references teach *every* element of the claim. M.P.E.P. §2143.03. *Bellis*, *Novak*, or *Bellis* in light of *Novak* fail to teach *every* element of claim 9. Therefore, because the Office Action fails to satisfy one of

the three factors required to prove a *prima facie* case of obviousness, claim 9 is not obvious in light of the cited references.

Claim 9 provides:

A check-out method ... comprising the steps of:

...

examining said product while said product is in said substantially enclosed area;

establishing ... physical features for said product while said product is in said substantially enclosed area;

...

deactivating said tag ... while said product is in said substantially enclosed area.

Thus, claim 9 recites a method that "examine[s] said product", "establish[es] one or more physical features for said product", and "deactivat[es] said tag ... while said product is in said substantially enclosed area."

In contrast, the Office Action provides that (i) *Bellis* deactivates a product's security tag while the product is in the detection area and that (ii) *Novak* teaches "an enclosure cover[s] the detection area." Therefore, "using *Novak*'s teaching, an enclosure covered the detection area, and automatically this enclosure would also encompass the deactivation system, since *Bellis*' deactivation system occurs with products that are in the sensing area." (Office Action, pp. 3-4). However, further analysis of *Bellis* illustrates the shortcomings in this proposition.

Bellis provides:

The bagging station 270 may further include one or more electronic article – surveillance monitors 300 . . . for verifying that all the items have been scanned into the self-check out system 100 and deactivating

the magnetic security tag on the item. Alternatively, the electronic surveillance deactivator may also be incorporated within the identification-code leader 120.

(*Bellis*, p. 2, ¶ 19; Fig. 1). *Bellis* further provides:

The system 100 may also include an item-shape sensor 600 as shown in Figure 2. The item-shape sensor 600 may be positioned between the scanning/payment station 110 and the bagging station 270. The item-shape sensor 600 generally comprises a tunnel 602 with a conveyor belt 603 moving at the base of the tunnel 602.

(*Bellis*, p. 2, ¶ 20; Figs. 1-2). Thus, *Bellis* places an item-shape sensor 600 between the scanning station 110 and the bagging station 270. *Bellis* had earlier provided that any electronic article surveillance deactivator 120, 300 would be located in the scanning station 110 or bagging station 270. In short, *Bellis* provides an item-shape sensor 600, comprising a tunnel, that is located in between the disclosed locations for article surveillance deactivators 120, 300. Thus, *Bellis* does not teach or suggest the element in claim 9 concerning "deactivating said tag . . . while said product is in said substantially enclosed area."

Novak fails to remedy *Bellis'* shortcomings. *Novak* provides:

The items are placed on the conveyor by the customer, and are automatically conveyed into an enclosed housing containing an illumination source . . . and video imaging equipment Digital image processing techniques and technology are used to identify the items by taking a digitized image of the object By correlating the digital image of each object to additional identification characteristic of the item, a precise determination of proper identity is accomplished
....

(*Novak*, Col. 2, lines 12-31). Thus, *Novak* discloses an "enclosed housing" 4 (Fig. 1) wherein a product is analyzed. This housing is analogous to the tunnel 602 associated with the item-shape sensor 600 in *Bellis* (Fig. 2). Consequently, as far as use of a tunnel or house is concerned, *Novak* adds little to *Bellis*.

Put another way, when *Bellis* contemplated use of a tunnel to analyze a product, any deactivation of security tags took place outside of that tunnel at the scanning station 110 or the bagging station 270. (*Bellis*, p. 2, ¶ 19-20). *Novak* is just another example of a housing area used for analysis of a product. In short, neither *Bellis* nor *Novak*, or their combination, consider the deactivation of tags in a substantially enclosed area. In other words, a person of ordinary skill in the art looking at *Bellis* and/or *Novak* would appreciate no teaching or suggestion for the element in claim 9 concerning "deactivating said tag . . . while said product is in said substantial enclosed area." The only such teaching or suggestion is found in the applicant's disclosure. To avoid impermissible hindsight, judgments on obviousness may take into account only knowledge that was in the level of ordinary skill in the art and may not include knowledge gleaned only from the applicant's disclosure. M.P.E.P. § 2145; *In Re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971).

Consequently, Applicant respectfully asserts that the Examiner has failed to prove a *prima facie* case of obviousness in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak* because the references do not teach or suggest all of the elements of the claim (i.e., deactivating said tag . . . while said product is in said substantially enclosed area.) M.P.E.P. §2143.03; *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998) (§103 rejections must not rely on incorrect factual predicates such as failing to appreciate differences between a claim and prior art.) As a result, claim 9 (and dependent claims 10 - 17) are not obvious in light of the cited references.

B. No Motivation to Combine the Cited References

Rejections under § 103 require evidence of some motivation or suggestion to modify the reference or to combine reference teachings. The cited references cannot be modified or combined as proposed by the Examiner due to the Examiner's failure

to provide a motivation to combine the cited references. M.P.E.P. § 2143.01. Therefore, because the Office Action fails to satisfy one of the three factors required to prove a *prima facie* case of obviousness, claim 9 is not obvious in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak*.

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the asserted reference(s), and the knowledge of persons of ordinary skill in the art. M.P.E.P. § 2143.01; *In Re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). These three sources are addressed below.

Nature of the Problem to be Solved

Claim 9 is not obvious in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak* considering the cited references cannot be modified or combined as proposed by the Examiner because the references address different problems (one of the three possible sources of motivation to combine references). M.P.E.P. § 2143.01.

A motivation to combine references may be based on the nature of the problem to be solved when each reference is directed to "precisely the same problem." *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270 (Fed. Cir. 2004).

Bellis addresses the following problem:

[T]he current self check out system may still require a high degree of store employee or operator intervention. Because a machine lacks the judgment of a human being, these systems tend to be very rigid and inflexible. Hence a need exists for a system that provides more efficient throughout and retains adequate security.

(*Bellis*, p. 1, ¶ 6). Thus, *Bellis* addresses security concerns and speed.

In contrast, *Novak* is directed towards the following problem:

Methods [that] provide a relatively simple system for the automated check-out of retail items as not dependent upon the involvement of customer or store personnel.

(*Novak*, Col. 1, line 66 – Col. 2, line 2). *Novak* addresses systems that are automated and, unlike *Bellis*, do not require human intervention. Thus, *Bellis* and *Novak* are not addressed towards "precisely the same problem." Therefore, the "nature of the problem" factor illustrates there is no suggestion or motivation to modify the references.

Thus, Applicant respectfully asserts that the Examiner has failed to prove a *prima facie* case of obviousness for claim 9 (as well as dependent claims 10 – 17) in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak*, considering the cited references cannot be modified or combined as proposed by the Examiner because the cited references address different problems (i.e., security vs. automated check-out). M.P.E.P. § 2143.01.

Teachings of the Asserted References

Claim 9 is not obvious in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak* because the teachings of the asserted references do not provide or suggest a motivation to modify or combine the references. M.P.E.P. § 2143.01.

The Office Action states that:

[T]he concept of 'teaching away' is based on the idea that a first invention would not function properly or would not fulfill its intended purpose if modified based on the teachings of the second invention . . . there is no reason to believe that surrounding the detecting area of *Bellis*' enclosure would somehow stop it from working properly.

(Office Action, p. 3). The Office Action fails to supply any legal precedent for this assertion. In fact, the concept of 'teaching away' is not so limited. For example, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. M.P.E.P., § 2141.02; *W.L.*

Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Furthermore, the general nature of the teaching is highly relevant in determining whether the references teach away from the claimed invention. M.P.E.P. § 2145 (X)(D); *In Re Gurly*, 27 F.3d 551, 554 (Fed. Cir. 1994).

Claim 9 provides the following: "deactivating said tag ... while said product is in said substantially enclosed area." Doing so provides many advantages, one of which is the prevention of "sweethearting" by a thief. One example of "sweethearting" occurs when a thief uses a check-out system to deactivate a security tag on a first item that was or will be correctly paid for by a thief. While such a deactivation occurs, the thief places a second item (one he has no intention of paying for) in proximity to the first item. Consequently, the second item's security tag is wrongfully deactivated along with the first item's security tag. Claim 9 specifically addresses this issue because claim 9 "examine[s] said product", "establish[es] ... physical features for said product", and "deactivat[es] said tag ... while said product is in said substantially enclosed area." In short, claim 9 prevents sweethearting.

In contrast, *Bellis* provides that a "bagging station 270 may further include ... deactivators." (*Bellis*, p. 2, ¶ 19). The bagging station 270 is located in open space and is consequently susceptible to sweethearting. (Figure 1). *Bellis* also allows for the deactivator to be "incorporated within the identification-code reader 120." (*Bellis*, p. 2, ¶ 19). As was the case with the bagging station location, the identification-code reader is located in open space and is consequently susceptible to sweethearting. (*Bellis*, Fig. 1). Simply put, *Bellis* fails to even contemplate a significant advantage (i.e., prevention of sweethearting) provided by claim 9. Further, *Bellis* uses an open space for deactivation and thus teaches away from deactivation using an enclosed area.

Novak cannot remedy *Bellis'* shortcoming because *Novak* doesn't even address deactivating security tags. Instead, *Novak* targets the automated assessment of physical characteristics of objects – not theft prevention.

Thus, Applicant respectfully asserts that the Examiner has failed to prove a *prima facie* case of obviousness for claim 9 (as well as dependent claims 10 – 17) in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak*, considering the cited references cannot be modified or combined as proposed by the Examiner because they teach away from the claimed invention. M.P.E.P. § 2145(D) (*Bellis* uses an open space for deactivation and *Novak* does not address deactivation).

Knowledge of Persons of Ordinary Skill in the Art

Claim 9 is not obvious in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak* because the third possible source for a motivation to combine the references, the knowledge of persons of ordinary skill in the art, does not provide or suggest a motivation to modify or combine the references. M.P.E.P. § 2143.01; *In Re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998).

Even when a "technologically simple concept" is claimed, it must be a finding "as to the specific understanding of principle within the knowledge of the skilled art" that would have provided the motivation to use, combine or modify the references as proposed by the examiner. *In Re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). The Office Action lacks any such "specific understanding" and merely provides:

In view of *Novak*'s teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known measurement of physical characteristics in an enclosed area at the checkout because otherwise a would-be shoplifter might interfere with sensor results inside the measurement area. The examiner envisions a would-be shoplifter attempting to change product detection outcomes by interfering with the detected parameters . . . in

order to indicate to the sensor that there is a different/cheaper product present

(Office Action, pp. 3-4). What "the examiner envisions" does not rise to the requirement for a "specific understanding." In fact, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. M.P.E.P. § 2143.01; *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). In short, the only evidence in the record regarding deactivating a security tag in a substantially enclosed area is in the applicant's disclosure. However, a suggestion or motivation to combine references may not be based on the applicant's disclosure. M.P.E.P. § 2142; *In Re Baeck*, 947 F.2d 488 (Fed. Cir. 1991).

Consequently, Applicant respectfully asserts that the Examiner has failed to prove a *prima facie* case of obviousness for claim 9 (as well as dependent claims 10-17) in light of the cited references, considering those references cannot be combined or modified as proposed by the Examiner because there is no suggestion or motivation to modify or to combine the reference teachings based on knowledge of persons of ordinary skill in the art. M.P.E.P. §2143.01; *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998) (court requires the examiner to show a motivation to combine the §103 references based on "nature of the problem", "teachings of the prior art" or "knowledge of persons of ordinary skill in the art").

In short, claim 9 and its dependent claims 10-17 are not obvious in light of *Bellis, Novak* or *Bellis* in light of *Novak* for at least the above reasons.

Claims 24 - 32

As in the case with claim 9, independent amended claim 24, and its dependent claims 25 - 32, are not obvious in light of *Bellis, Novak*, or *Bellis* in view of *Novak* for any of the following reasons.

Amended claim 24 provides:

A check-out system...comprising:

...

a[n] ... evaluator for establishing ... physical features ... while said product is in said substantially enclosed area;

...

a deactivation device for deactivating said tag ... while said product is in said substantially enclosed area.

Thus, amended claim 24 "establish[es] physical features" and "deactivat[es] said tag ... while said product is in said substantially enclosed area."

A. Cited References Fail to Teach Every Element of Claim

As was the case with claim 9, Applicant respectfully asserts that the Examiner has failed to prove a *prima facie* case of obviousness in light of *Bellis, Novak*, or even a combination of *Bellis* and *Novak* because the references do not teach or suggest all of the elements of the claim (i.e., a deactivation device for deactivating said tag ... while said product is in said substantially enclosed area.) M.P.E.P. §2143.03; *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998) (§103 rejections must not rely on incorrect factual predicates such as failing to appreciate differences between a claim and prior art.) As a result, claim 24 (and dependent claims 25 - 32) are not obvious in light of the cited references.

B. No Motivation to Combine the Cited References

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the asserted reference(s), and the knowledge of persons of ordinary skill in the art. M.P.E.P. § 2143.01; *In Re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). These three sources are addressed below.

As was the case with claim 9, Applicant respectfully asserts that the Examiner has failed to prove a prima facie case of obviousness for claim 24 (as well as dependent claims 25 – 32) in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak*, considering there is no motivation to combine the cited references because the cited references address different problems (i.e., security vs. automated check-out). M.P.E.P. § 2143.01.

Also, as was the case with claim 9, Applicant respectfully asserts that the Examiner has failed to prove a prima facie case of obviousness for claim 24 (as well as dependent claims 25 – 32) in light of *Bellis*, *Novak*, or even a combination of *Bellis* and *Novak*, considering there is no motivation to combine the cited references because they teach away from the claimed invention. M.P.E.P. § 2145(D) (*Bellis* uses an open space for deactivation and *Novak* does not address deactivation).

In addition, as was the case with claim 9, Applicant respectfully asserts that the Examiner has failed to prove a prima facie case of obviousness for claim 24 (as well as dependent claims 25-32) in light of the cited references, considering those references cannot be combined or modified as proposed by the Examiner because there is no suggestion or motivation to modify or to combine the reference teachings based on knowledge of persons of ordinary skill in the art. M.P.E.P. §2143.01; In re Rouffet, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998) (court requires the examiner to show a motivation to combine the §103 references based on "nature of the problem", "teachings of the prior art" or "knowledge of persons of ordinary skill in the art").

In short, claim 24, and its dependent claims 25 - 32, are not obvious in light of *Bellis*, *Novak*, or *Bellis* in view of *Novak* for at least the above reasons.

VIII. CONCLUSION

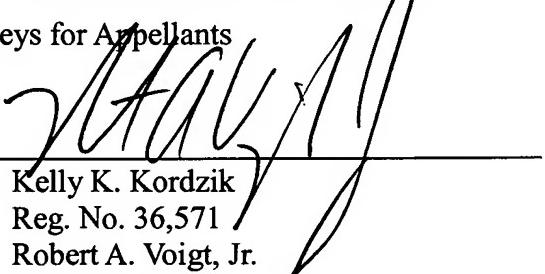
For the reasons noted above, the rejections of claims 9-17 and 24-32 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 9-17 and 24-32.

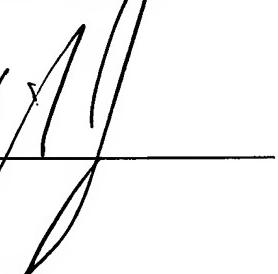
Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Appellants

By:


Kelly K. Kordzik
Reg. No. 36,571


Robert A. Voigt, Jr.
Reg. No. 47,159

P.O. Box 50784
Dallas, Texas 75201
(512) 370-2832

CLAIMS APPENDIX

1 9. A check-out method for a product having a security tag associated therewith,
2 comprising the steps of:

3 storing one or more physical characteristics for said product;
4 recalling said one or more physical characteristics when a consumer checks
5 out said product;

6 placing said product in a substantially enclosed area;
7 examining said product while said product is in said substantially enclosed
8 area;

9 establishing one or more physical features for said product while said product
10 is in said substantially enclosed area;

11 comparing said one or more physical characteristics to said one or more
12 physical features;

13 generating a signal if said one or more physical characteristics substantially
14 match said one or more physical features; and

15 deactivating said tag with a deactivation device after receipt of said signal and
16 while said product is in said substantially enclosed area.

1 10. The method according to claim 9 wherein said one or more physical
2 characteristics and said one or more physical features pertain to weight.

1 11. The method according to claim 9 wherein said one or more physical
2 characteristics and said one or more physical features pertain to size.

1 12. The method according to claim 9 wherein said one or more physical
2 characteristics and said one or more physical features pertain to shape.

1 13. The method according to claim 9 wherein said one or more physical
2 characteristics and said one or more physical features pertain to color.

1 14. The method according to claim 9 wherein said one or more physical
2 characteristics and said one or more physical features pertain to two or more of the
3 following: weight, size, shape, color or surface texture.

1 15. The method according to claim 9 further comprising the step of ensuring no
2 other object is in said substantially enclosed area once said product has been placed in
3 said substantially enclosed area but before said tag has been deactivated.

1 16. The method according to claim 15 further comprising the step of generating
2 an alert signal if an object, in addition to said product, is detected to be in said
3 substantially enclosed area once said product has been placed in said substantially
4 enclosed area but before said tag has been deactivated.

1 17. The method according to claim 16 further comprising the step of preventing
2 any deactivation of said tag once said alert signal has been generated.

1 24. A check-out system for a product having a security tag associated therewith,
2 comprising:

3 a substantially enclosed area;
4 a database for storing one or more physical characteristics for said product;
5 a scanner for retrieving from said database said one or more physical
6 characteristics;
7 a physical characteristic evaluator for establishing one or more physical
8 features for said product while said product is in said substantially enclosed area;
9 a computer for comparing said one or more physical characteristics to said one
10 or more physical features;
11 an electronic circuit for generating a signal if said one or more physical
12 characteristics substantially match said one or more physical features; and
13 a deactivation device for deactivating said tag after receipt of said signal and
14 while said product is in said substantially enclosed area.

1 25. The system according to claim 24 wherein said one or more physical
2 characteristics and said one or more physical features pertain to weight.

1 26. The system according to claim 24 wherein said one or more physical
2 characteristics and said one or more physical features pertain to size.

1 27. The system according to claim 24 wherein said one or more physical
2 characteristics and said one or more physical features pertain to shape.

1 28. The system according to claim 24 wherein said one or more physical
2 characteristics and said one or more physical features pertain to color.

1 29. The system according to claim 24 wherein said one or more physical
2 characteristics and said one or more physical features pertain to two or more of the
3 following: weight, size, shape, color or surface texture.

1 30. The system according to claim 24 further comprising a means for ensuring no
2 other object is in said substantially enclosed area once said product has been placed in
3 said substantially enclosed area but before said tag has been deactivated.

1 31. The system according to claim 30 further comprising means for generating an
2 alert signal if an object, in addition to said product, is detected to be in said
3 substantially enclosed area once said product has been placed in said substantially
4 enclosed area but before said tag has been deactivated.

1 32. The system according to claim 31 further comprising means for preventing
2 any deactivation of said tag once said alert signal has been generated.

EVIDENCE APPENDIX

No evidence was submitted pursuant to §§1.130, 1.131, or 1.132 of 37 C.F.R. or of any other evidence entered by the Examiner and relied upon by Appellant in the Appeal.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings to the current proceeding.

Austin_1\292321\1
7036-P255US 9/26/2005